REMARKS

Claims 1, 3-7 and 9-27 remain pending in the application, unchanged.

In compliance with the Examiner's drawing requirement made in the December 14, 2004 Action, two sheets of new drawings are submitted herewith. The specification has been amended in minor respects to refer thereto. No new matter has been added.

The title has been changed, to better correspond to the claimed subject matter. (E.g., claim 7 deals with improvements to shopping in a bricks and mortar store, making the prior title's reference to "facilitating on-line shopping" somewhat misdescriptive.)

Regarding the Interview Summary Record, the undersigned does not recall stating that he would submit a claim as outlined by the Examiner. Rather, notes in the file indicate that the undersigned said that he would *consider* adding a further limitation to claim 9. After further consideration, no such amendment is believed warranted. The claims are unamended.

Claims 20-23 stand rejected as anticipated by Treyz et al (6,587,835), with the Action particularly citing col. 16, lines 37-55, and Figs. 21 and 63. (The Treyz patent is over 150 pages in length, so applicants are relying on the Examiner to have cited the most relevant passage.)

Treyz is not understood to teach these claims' limitations. The cited passage in the specification reads:

> *The user may provide inputs using user input interface 134. User input interface 134 may be, for example, an on-screen keyboard, a keyboard, a touch screen, a touch pad, keys or buttons, a microphone (e.g., for voice commands), a pointing device (e.g., a trackball or mouse, etc.), etc. Communications circuitry and accessories 136 may include antennas, transmitter/receivers, and other communications circuitry and may be used to handle wired and wireless communications tasks. Wireless communications circuitry may be provided for local communications functions, remote communications functions, or both local and remote communications functions. Communications and accessories 136 may include IR communications circuitry for local optical communications. Communications and accessories 136 may also include a bar code scanner for scanning bar code labels on items in stores and the like or an RFID unit for identifying items wirelessly. Other features, such as printing, scanning, and the like may be provided by other suitable communications circuitry and accessories.*

This passage is understood to disclosure certain of the hardware arrangements employed by an embodiment of the Treyz system.

This passage <u>fails</u> to disclose the limitations defined by applicants' method claims 20-23, e.g.:

- *collecting data about products of interest during a shopper's visit to a bricks and mortar store, said data being collected prior to check-out; and using the data thereby acquired in a later on-line shopping session with said shopper*; nor

- *wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store;* nor

- *the data collection includes shopper activation of a shelf-based sensor associated with a product of interest;* nor

- *the data collection includes shopper use of a sensor device in the aisle of the store to collect data relating to a product of interest.*

Nor do the cited drawings teach such claim limitations. Treyz's Fig. 21 is as follows:
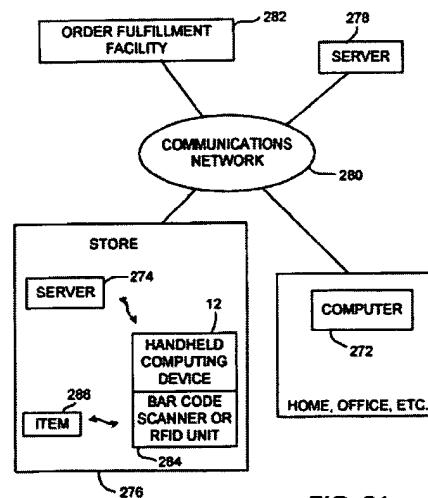

FIG. 21

Fig. 63 is as follows:

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        ┌──────────────────┐
        │  ALLOW USER TO   │
        │     REQUEST      │
        │ NOTIFICATION BY  │
        │     MERCHANT     │ 638
        └──────────────────┘
                 │ USER REQUESTS NOTIFICATION
                 ▼
        ┌──────────────────┐
        │  MERCHANT SENDS  │
        │ NOTIFICATION TO USER │ 640
        └──────────────────┘
                 │
                 ▼                    642
        ┌──────────────────────┐
        │  PROVIDE USER WITH   │
        │ OPPORTUNITY TO RESPOND │
        │ TO NOTIFICATION AND TAKE │
        │    OTHER ACTIONS     │
        └──────────────────────┘
```
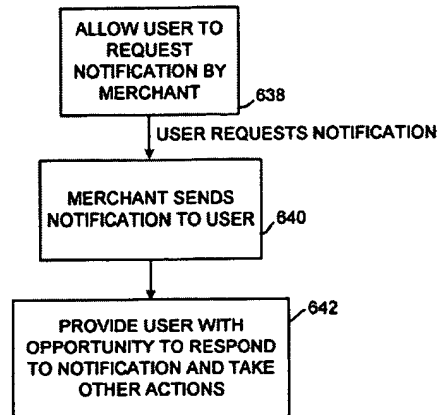
FIG. 63

Because Treyz fails to teach the limitations of claims 20-23, the anticipation rejection of such claims should be withdrawn.

Claims 1 and 7 stand rejected as anticipated by Scroggie (5,970,469).

These claims were earlier rejected as obvious over Scroggie in view of other art. In prior responses, and in the Appeal Brief, applicants demonstrated how Scroggie fails to render these claimed combinations obvious. Since the art does not render the claims obvious, necessarily such art cannot anticipate.

Indeed, in the March 3, 2004, Final Action, the Examiner admitted that Scroggie *"does not specifically mention that the information gathered during online shopping is presented to a user in connection with a brick and mortar shopping environment,"* as required by claim 7.[1] As to claim 1 the Examiner admitted that Scroggie *"does not specifically mention that the scan data is presented to the user in a shopping environment."*[2] Thus, Scroggie does not anticipate such claims.

Given such shortcomings of Scroggie, and the Examiner's earlier admissions confirming same, the anticipation rejection should be withdrawn.

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[1]   March 3, 2004, Final Action, page 4, lines 7-8.
[2]   March 3, 2004, Final Action, page 3, lines 6-7.

Claims 10, 11 and 24-26 stand rejected over Scroggie in view of Treyz. These claims each depend from claim 1.

Since – as noted above and as earlier admitted by the Examiner – Scroggie fails to teach each of the elements of claim 1, the Action fails to present a *prima facie* showing that the combinations defined by claims 10, 11 and 24-26 are met by Scroggie + Treyz.

Since the Action failed to meet the Office's initial burden of demonstrating obviousness, other points that might be noted regarding the rejection are not belabored.

The obviousness rejections of claims 10, 11 and 24-26 should be reversed.

Claims 3-5, 9, 12-19 and 27 stand rejected as obvious over Kenney (6,381,583) in view of Treyz.

Regarding independent claim 3, the Action notes that Kenney does not specifically mention that a login identifier is used to identify the user, and seeks support for Treyz for such limitation.

However, the Action failed to acknowledge <u>another</u> shortcoming of Kenney. As admitted by the Examiner in his March 3, 2004, Final Action, Kenney also *"does not specifically mention querying the user regarding the possible purchase of an item not selected by the user but on said recalled list, before completing the online shopping session."*[3] (Claim 3 specifies that such "querying…" happens *after* the user has indicated that he/she is finished selecting products.)

Neither Kenney nor Treyz teaches such limitation. (The current Action cites Figs. 5 and 7 for such limitation, but such figures do not disclose, *e.g.*, querying the user after the user has indicated that he/she is finished selecting products, as required by the claim.)

Claims 4, 5, 12-14, and 27 depend from claim 3. Since the Office failed to establish *prima facie* obviousness as to claim 3, applicants do not lengthen this response by pointing out further errors in the rejections of these other claims.

Claim 6 stands rejected over Kenney in view of Treyz, and further in view of Official Notice. Like claims 4, 5, 12-14 and 27, claim 6 is dependent from claim 3. In view of the Office's failure to demonstrate *prima facie* unpatentability of claim 3, this

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[3]   March 3, 2004, Final Action, page 5, lines 14-16.

claim is also not further belabored. If the rejection is renewed, the Examiner is requested to provide a citation to illustrative art showing the subject matter for which "Official Notice" is presently cited, so the Board can more fully consider same.

Turning to claim 9, Kenney teaches graphically representing items for sale in an on-line store. Kinney's Fig. 7 shows that certain graphical product representations in his virtual aisle can be flagged with signs "SPECIAL TODAY" and "REORDER ITEM" – which are said to meet the claim requirement that *"items of potential interest to a shopper are presented more prominently than other items."*

Treyz mentions a barcode reader 284, which Treyz teaches can be used in a store to identify items. For example, Treyz notes that a child may scan an article of clothing in a store, to add it to a "wish list."

However, such facts do not render claim 9 obvious.

There is nothing – absent hindsight – in the references that would have suggested that an item identified by Treyz' barcode scanner (e.g., for inclusion on a "wish list") be presented more prominently than other items in a virtual shopping aisle with graphical product representations. That is a leap of logic made by the Examiner – not a suggestion made by the art.

The rationale offered in the Action for such a leap is insufficient. The Action states that the arrangement of claim 9 would have been obvious *"because this would provide an efficient means for gathering data to present a shopping list."*

It will be recognized that this rationale does not address the claimed arrangement. The claimed arrangement does not yield a shopping list. Rather, the invention of claim 9 is a method of displaying a virtual shopping aisle, with some items featured more prominently than others.

Moreover, to the extent that the rationale relates to the claim, it seems to start with an advantage associated with applicants' claimed arrangement, and by hindsight posit this advantage as a basis for the proposed combination. Obviousness is not established by such circular reasoning.

Since neither reference teaches or suggests that an item - identified as being of potential interest by activity in a bricks and mortar store - be presented more prominently than other items in a virtual shopping aisle of an online store, obviousness has not been established, and the rejection of claim 9 should be reversed.

Claims 15-16 depend from claim 9. Since *prima facie* obviousness has not been demonstrated as to claim 9, neither has it been demonstrated for any dependent claim. Accordingly, applicants do not lengthen this response by particularly addressing such claims.

Independent claim 17 is similar to claim 9, and further specifies that at least one item of interest – presented more prominently than other items in the virtual shopping aisle – is one that the shopper has not previously purchased from the online vendor.

The rejection of this claim suffers the same deficiencies as discussed above in connection with claim 9.

Additionally, the Office has failed to substantively address the limitation specifying that at least one item of interest – presented more prominently than other items in the virtual shopping aisle – is one that the shopper has not previously purchased from the online vendor. Instead, such claim limitation is presented in the Action <u>after</u> the proposed rationale for combining Kenney and Treyz,[4] and is not addressed by such rationale.

Claim 18 is also similar to claim 9, and further specifies that the prior shopping history (by which items of potential interest are identified) includes transactions with vendors other than the first vendor.

The rejection of this claim suffers the same deficiencies as discussed above in connection with claim 9.

Moreover, the Office has failed to substantively address the limitation specifying that the prior shopping history include transactions with vendors other than the first vendor. Instead, the Action simply recites the claim language. No reference to any suggestion or teaching concerning "vendors other than the first vendor" is offered.

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[4]   December 14, 2004, Action, page 11, 5th and 4th lines from the bottom.

Again, *prima facie* obviousness has not been established.

Claim 19 is also similar to claim 9, but differs by specifying that at least some of the items of potential interest are identified by sensing identification data from products <u>while at the shopper's residence</u>.

The rejection of this claim suffers the same deficiencies as discussed above in connection with claim 9.

Again, this claim defines a combination for which the Office resorts to hindsight as a basis for rejection. Nothing in the art suggests that products <u>identified at home</u> should be <u>prominently displayed</u> as being of potential interest in a virtual aisle of an online store.

<u>IDS</u>

With the filing of this application in February, 2000, applicants submitted an unsolicited idea submission received by email by the present assignee. This email was identified on an IDS form, which was returned – uninitialed and without comment – with the December 14, 2004, Action. The Office is requested to consider such reference, or offer an explanation for its refusal to do so.

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CUSTOMER NUMBER 23735

Phone: 503-885-9699
FAX 503-885-9880

Respectfully submitted,

DIGIMARC CORPORATION

By_____
William Y. Conwell
Registration No. 31,943